



# UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,278	12/16/2003	Tilo Dittrich	DT-6693	6177

30377 7590 04/05/2005

DAVID TOREN, ESQ.  
SIDLEY, AUSTIN, BROWN & WOOD, LLP  
787 SEVENTH AVENUE  
NEW YORK, NY 10019-6018

EXAMINER
----------

CHUKWURAH, NATHANIEL C

ART UNIT	PAPER NUMBER
----------	--------------

3721

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

512

<b>Office Action Summary</b>	<b>Application No.</b> 10/737,278	<b>Applicant(s)</b> DITTRICH ET AL.	
	<b>Examiner</b> Nathaniel C. Chukwurah	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,13,14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 10,11,15 and 19-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of specie 1, Figs. 1-6 and claims 1-3,5-6,8,10,11 and 13-22 in the reply filed on 3/15/2005 is acknowledged. The traversal is on the ground(s) that a prior art search for the power tool with a sealing sleeve and the seal itself would be co-extensive. The search of prior art for a sealing sleeve would be necessarily involve a search for the sleeve itself, and the search for a sealing sleeve would necessarily involve a search for device and apparatuses the sealing sleeve can be used. This is not found persuasive because the species are patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

Claim 19 is objected to because of the following informalities:

Claim 19 is dependent upon itself; however, for the purpose of examination, it will be treated as dependent upon claim 18.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3721

In claim 2, the phrase "central axes of the cavity and the piston chamber are inclined toward each other. This is not true because the axes are at 90 degrees, not at inclined as claimed.

Therefore, claim 2 is not consistent with Figure 1 of the drawing.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-6, 8, 13-14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehmig (US 6,286,743).

With regard to claim 1, Ehmig discloses an explosive-operated power tool comprising: a housing (1, 2) having a cylinder cavity (7), and a piston chamber (21), for receiving a drive piston (22), a breech bottom (2) located opposite the cavity (21), a sealing sleeve (9) and a cartridge (4).

With regard to claim 5, Ehmig shows the sealing sleeve having surfaces (14, 16).

With regard to claim 6, Ehmig shows a bottom surface (16) of the sealing sleeve spaced from a bottom of cavity (7) when sealing receives the cartridge (4 fig.1).

With regard to claim 8, Ehmig shows circumferential seal (8) encompassing the sealing sleeve (9).

With regard to claim 13, Ehmig does not expressly state that the displaceable sealing sleeve is displaced by a spring against the breech bottom, the sealing sleeve is deemed displaced by a spring.

Art Unit: 3721

With regard to claim 14, Ehmig's tool inherently includes an actuation element provided at a front of tool (portion placed on work surface) and displaceable relative to the housing.

With regard to claim 16, Ehmig shows cartridge (4) fed in a region between the sealing sleeve (9) and breech bottom (2 fig. 1).

With regard to claim 17, Ehmig shows blister cartridge (4) formed in belt.

With regard to claim 18, Ehmig shows cartridge as claimed in Figure 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehmig.

With regard to claims 2 and 3, Ehmig fails to show inclined central axes of the cavity and piston chamber; however, it would have been obvious design choice to modify the reference of Ehmig by having the central axes of the cavity and piston chamber inclined to each other, since applicant does not disclose that having inclined central axes solves any stated problem and it appears that the tool will perform equally well with the central axes of the cavity and piston chamber in non-inclined towards each other.

### ***Allowable Subject Matter***

Claims 10, 11, 15, 19-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3721

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fail to disclose or suggest a guide pin projecting from the housing into the cavity, and for guiding the sealing sleeve.

The prior art fail to disclose or suggest a spring fork for retaining the sealing sleeve upon displacement of the actuation member.

The prior art fail to disclose or suggest an end of the sealing sleeve having a circumferential nose-shaped projection extending axially and radially inward.

### ***Conclusion***

Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

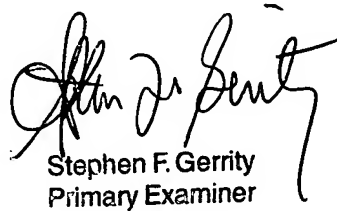
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

March 31, 2005.



Stephen F. Gerrity  
Primary Examiner